

REMARKS

I. Status of the Claims

Claims 1-167 are pending in this application. As a minor correction to the record, Applicants note that the Office Action summary states that claims 1-157 are pending and subject to a restriction and/or election requirement, when in fact claims 1-167 are pending and subject to a restriction and/or election requirement. Clarification is respectfully requested in the next communication from the Examiner.

II. Restriction Requirement

In the Office Action dated August 27, 2004, the Examiner has required restriction between the following groups of claims:

Group I Claims 1-15 (all in part), 16-23, 25-28 (all in part), 29-31, 32-63 (all in part), 64-71, 73-76 (all in part), 77-79, 81-101 (all in part), 102-109, 111-117, 118-135 (all in part), 136-143, 145-148 (all in part), 149-151, and 152-167 (all in part) which, according to the Examiner, are drawn to composition, method of use and kit wherein the at least one compound is C5-C7 monosaccharides substituted with at least one amino group;

Group II Claims 1-15 (all in part), 24, 25-28 (all in part), 32-63 (all in part), 72, 73-76 (all in part), 80-101 (all in part), 110, 118-135 (all in part), 144, 145-148 (all in part), and 152-167 (all in part) which, according to the Examiner, are drawn to composition, method of use and kit wherein the at least one compound is polymers comprising at least C5-C7 monosaccharides substituted with at least one amino group; and

Group III Claims 1-15 (all in part), 25-28 (all in part), 32-63 (all in part), 73-76 (all in part), 81-101 (all in part), 118-135 (all in part), 145-148 (all in part), and 152-167 (all in part) which, according to the Examiner, are drawn to composition, method of use and kit wherein the at least one compound is glycoproteins comprising C5-C7 monosaccharides substituted with at least one amino group.

The Examiner has additionally required an election of species, under 35 U.S.C. § 121. For any of the three groups chosen, the Examiner required Applicants to choose one of fifteen species.

For example, if **Group I** is chosen then the Examiner required the selection of one of the following species:

1. C5 monosaccharides substituted with at least one amino group;
2. C6 monosaccharides substituted with at least one amino group;
3. C7 monosaccharides substituted with at least one amino group;
4. Imine derivatives of C5 monosaccharides substituted with at least one amino group;
5. Imine derivatives of C6 monosaccharides substituted with at least one amino group;
6. Imine derivatives of C7 monosaccharides substituted with at least one amino group;
7. Hemiacetal derivatives of C5 monosaccharides substituted with at least one amino group;
8. Hemiacetal derivatives of C6 monosaccharides substituted with at least one amino group;

9. Hemiacetal derivatives of C7 monosaccharides substituted with at least one amino group;
10. Hemiketal derivatives of C5 monosaccharides substituted with at least one amino group;
11. Hemiketal derivatives of C6 monosaccharides substituted with at least one amino group;
12. Hemiketal derivatives of C7 monosaccharides substituted with at least one amino group;
13. Oxidized derivatives of C5 monosaccharides substituted with at least one amino group;
14. Oxidized derivatives of C6 monosaccharides substituted with at least one amino group; and
15. Oxidized derivatives of C7 monosaccharides substituted with at least one amino group.

To be responsive to the requirement, Applicants elect, with traverse, (a) Group I drawn to composition, method of use and kit wherein the at least one compound is C5-C7 monosaccharides substituted with at least one amino group, and (b) the species drawn to C6 monosaccharides substituted with at least one amino group.

Applicants traverse the election among the three groups, at least because the Examiner has not applied the criteria and guidelines set forth in M.P.E.P. § 803 for making proper requirements for restriction under 35 U.S.C. § 121. The M.P.E.P. instructs Examiners as follows:

If the search and examination of an entire application can be made without serious burden, the Office must examine it on the merits, even though it includes claims to distinct or independent inventions.

M.P.E.P. § 803 (emphasis added).

Here, the Examiner has not shown that examining the above groups together would constitute a serious burden. In fact, the Examiner stated that each of the three Groups are classified in the same class and subclass, i.e., class 424, subclass 70.1. See Office Action at p. 2. Applicants therefore submit that searches for each of these groups of claims should substantially overlap and thus do not represent a serious burden to the Examiner.

Next, Applicants respectfully traverse the election of species requirement, at least, because the Examiner has similarly failed to show that a serious burden exists to examine all of the alleged species. To make a proper requirement for an election of species the Examiner must, inter alia, show that the search and examination of a claim would impose a serious burden on the Office because it embraces an unreasonable number of species. M.P.E.P. § 803.02 (emphasis added). Here, the Examiner has provided no reasons or evidence on the record to substantiate the election of species requirement, let alone how examination of all the species would impose a serious burden.

Moreover, when the requirement to elect one of the three Groups is viewed together with the species election requirement, Applicants respectfully submit that their statutory right under 35 U.S.C. § 112, second paragraph, to claim the subject matter they regard as their invention as they choose has been violated. Issuing a restriction

requirement within a claim with the idea that Applicants would have to carve up that claim and pursue the nonelected subject matter in a separate application violates this right under section 112. Indeed, the C.C.P.A. has characterized such action as tantamount to a refusal to examine. See, In re Weber, 198 U.S.P.Q. 328 (C.C.P.A. 1978); In re Haas, 198 U.S.P.Q. 334 (C.C.P.A. 1978). Here, the Examiner has carved up the each of the independent claims (and a majority of the dependent claims) into 45 (three by fifteen) groups. This effective 45-way restriction is extreme and unwarranted, and Applicants respectfully submit the Examiner has violated the section 112 rights of the Applicants with both the restriction and election of species requirements.

If the Examiner, however, chooses to maintain the restriction requirement, Applicants respectfully request that the Examiner, at least, examine the full scope of elected Group I without the species election requirement. If the Examiner chooses to maintain the election of species requirement, and if the elected species are found allowable, Applicants respectfully request that the Examiner continue to examine the full scope of the subject matter to the extent necessary to determine the patentability of the elected Group, pursuant to the guidelines set forth in M.P.E.P. § 803.02.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 29, 2004

By:



Mark D. Sweet
Reg. No. 41,469